

REMARKS/ARGUMENTS

Reconsideration of this application is respectfully requested.

Claims 1-4, 6-10, 12, and 14-21 are pending in the application with claims 5, 11, and 13 having been canceled, and new claims 14-21 having been added.

Support for new claims 14 and 18 appears in the specification in Examples 1 and 2.

Support for new claims 15 and 19 appears in the specification in Example 9.

Support for new claims 16 and 20 appears in the specification in Example 11.

Support for new claims 17 and 21 appears in the specification on page 8 at lines 20-22.

Claims 1-4 and 6 have been allowed.

The present invention is directed to, *inter alia*, a composition comprising an alkyl salicylic acid prepared by a process comprising reacting salicylic acid with an olefin having at least four carbon atoms at an elevated temperature in the range of from about 50°C to about 200°C in the presence of a perfluoroalkylsulfonic acid, an alkylsulfonic acid, or an acidic clay as a catalyst.

Claims 7-10 and 12 have been rejected under 35 U.S.C. 102(b) as being anticipated by Zon et al. (U.S. Patent No. 4,876,020), Van Wijngaarden et al. (U.S. Patent No. 4,869,837), and Van Kruchten et al. (U.S. Patent No. 4,810,398) .

Zon et al. disclose a lubricating oil composition comprising a lubricating base oil, one or more overbased alkaline earth metal salts of an aromatic carboxylic acid, and a stabilizing agent which has been selected from a polyalkoxylated alcohol having a molecular weight

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from 150 to 1500.

Van Wijngaarden et al. disclose a process for the preparation of a basic alkaline earth metal salt of a blend of organic carboxylic acids, which comprises (a) preparing a mixture of one equivalent of the blend of organic carboxylic acids and more than one equivalent of an alkaline earth metal hydroxide and/or oxide in a hydrocarbon solvent; (b) introducing carbon dioxide into the mixture obtained in an amount of at least 0.5 equivalent carbon dioxide per equivalent of excess alkaline earth metal; and (c) removing residual solids, if any, and an aqueous layer, if any, whereby the blend of organic carboxylic acids comprises an oil-soluble alkyl salicylic acid and one or more hydrocarbon substituted succinic acids or anhydrides, in which the hydrocarbon radical has a number average molecular weight from 120 to 5000.

Van Kruchten et al. disclose a basic alkaline earth metal salt of a blend of organic carboxylic acids that is prepared by (a) preparing a mixture of one equivalent of the blend of organic carboxylic acids and more than one equivalent of an alkaline earth metal hydroxide and/or oxide in a hydrocarbon solvent; (b) introducing carbon dioxide into the mixture obtained in an amount of at least 0.5 equivalent carbon dioxide per equivalent of excess alkaline earth metal; and (c) removing residual solids, if any, and an aqueous layer, if any, whereby the blend of organic carboxylic acids comprises a C₈₋₃₀ alkyl salicylic acid and one or more alkanecarboxylic acids in which the alkyl moiety is branched and has from 4 to 40 carbon atoms.

Thus, the present invention is directed to a particular process for making alkyl substituted salicylic acids, which the examiner has found to be novel and unobvious, and to the acids that are prepared by the process.

The three cited references are all directed to the use of an alkyl salicylic acid. Not one of them discloses any information whatsoever concerning the means by which the alkyl salicylic acids used were prepared. At the most, these references disclose that alkyl salicylic acids were known in the art prior to the present invention. This is not denied. As pointed out by the Examiner, Applicant has acknowledged in the specification on page 4 that this is so. However, it is maintained that alkyl substituted salicylic acids made by the novel process of the present invention were not known in the art.

The Examiner has simply said "that claims 7-10 and 12 are improper product-by-process claims" without any further comment as to why they may be "improper." Is the Examiner saying that *all* product-by-process claims are "improper?" This is clearly not the case. Product-by-process claims are perfectly proper where, as here, the product cannot be adequately described without reference to the process employed in its production.

It has been pointed out in the paragraph bridging pages 6 and 7 of the specification:

"The products are mixtures of ortho and para monoalkylated salicylic acids with some dialkylated and trialkylated salicylic acids. The alkyl phenol content is very low and the color of the product is excellent compared to that obtained via the Kolbe-Schmitt synthesis. The alkylated salicylic acids have acid

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numbers approximately 60-95% of the theoretical value."

It is submitted that there is no way that the novel product of the present invention, which is a varying mixture as described above, can be particularly pointed out and distinctly claimed other than by reference to the process by which it is produced. The precise identity of the product will vary depending upon the specific process steps employed.

In view of the foregoing, it is submitted that this application is now in condition for allowance and an early Office Action to that end is earnestly solicited.

Respectfully submitted,

27 Apr 2005
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